This is your new edition

How to Write a Patent Application

Third Edition

by Jeffrey G. Sheldon

(Leech Tishman, Pasadena)

The new Third Edition of Jeffrey G. Sheldon’s How to Write a Patent Application is an essential resource for patent practitioners across all industries and specialties. Updated and expanded, it provides the practical know-how needed to master every step of the patent application process and addresses concrete problems of both new and seasoned drafters.

Since it was first published in 1992, this book has guided thousands of practitioners through the statutes, regulations, Patent Office practices, and court rulings that must be understood in order to make an application successful.

The new Third Edition features 118 exhibits—PTO forms, sample correspondence with clients, flowcharts, checklists, illustrative patents, and more.

The author has added summaries of current Patent Office guidance on what constitutes patentable subject matter, including the PTO’s July 2015 Update on Subject Matter Eligibility, with key examples; discussion of special PTO initiatives such as the “patents for humanity” program, providing expedited examination for patent applications directed to technologies for humanitarian purposes; and a checklist of critical factors for consideration in advising a client whether to file a foreign application.

The new edition also includes new material on how generic terms such as “module,” “mechanism,” “element,” “device,” and other nonce words can be interpreted as a means-plus-function clause; why providing definitions drafted by the applicant may be a good idea given the PTO’s approach to claim construction; and why it may be dangerous to use the phrase “object of the invention” in the specification. It illuminates issues regarding divided and distributed claims, the consequences of late filing of an information disclosure statement, and design applications in the foreign filing context.

(continued on reverse)

Practising Law Institute
1177 Avenue of the Americas
New York, NY 10036

#151671
Selected sections of the patent statute and the Rules of Practice are included for easy reference. The book also includes a comprehensive table of authorities and a topical index.

Summary of Contents

1 Introduction, When to File and Where to Prepare the Application

About the Author

Jeffrey G. Sheldon is a partner of Leech Tishman. Previously, he was the founding partner of Sheldon Mak & Anderson PC, a leading West Coast intellectual property law firm with offices in Pasadena, California. Mr. Sheldon is a summa cum laude graduate of Loyola Law School. He has a Bachelor of Science degree in Chemical Engineering from the Carnegie Institute of Technology, and a Master of Science degree in Biomedical Engineering from the University of Strathclyde, Glasgow, Scotland. His studies in Scotland resulted from receiving the Marshall Scholarship from the United Kingdom government.

Mr. Sheldon has been litigating patents and prosecuting patent applications since 1975. He has been adjunct professor in intellectual property law and patent law at Southwestern University Law School and advanced patent law at Loyola University, both in Los Angeles. He is a frequent lecturer for the Practising Law Institute and other organizations. He is a member of the American Bar Association and the American Intellectual Property Law Association and was chairman of the Los Angeles Intellectual Property Law Association. Mr. Sheldon is a frequent author and was a columnist for the Los Angeles Daily Journal on intellectual property law. He is a past chairman of the Intellectual Property Law Section of the State Bar of California and was identified by California Lawyer magazine as one of the top patent lawyers in the state of California. Best Lawyers named him Best Patent Lawyer for 2012 for the Los Angeles area, an award determined by his peers.